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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,306	06/23/2000	Brian Wolfe	5053-36200	1775

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EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/603,306

Applicant(s)

WOLFE, BRIAN

Examiner

Natalie A. Pass

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: none.
- Claim(s) rejected: 1-4,6-9,11-25,27-39,41-51,53-56 and 58-61.
- Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


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Continuation of 11. does NOT place the application in condition for allowance because:

i. Applicant apparently rehashes arguments previously addressed in the Final Office Action (paper number 012505). In particular, each and every limitation of independent claims 1, 17, 31, and 47 and dependent claims 2-4, 6-9, 11-16, 18-25, 27-30, 32-39, 41-46, 48-51, 53-56, and 58-61, were properly addressed in pages 2-7 of the detailed Final Office Action and pages 2-20 of the detailed Non-Final Office Action, and are incorporated herein. In addition, the motivations to combine the applied references, were clearly accompanied by select portions of the respective references which specifically support each particular motivation [see paper number 012505, pages 2-15].

ii. Applicant analyzes the applied references separately in the Response After Final Office Action, and argues each of the references individually, and therefore fails to consider the full teachings of the applied references. In response to Applicant's piecemeal analysis of the references, it has been held, as noted in the Final Office Action, that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. *In re Jacoby*, 135 USPQ 317 (CCPA 1962).

iii. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

iv. In response to Applicant's assertion that a prima facie case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a prima facie case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Continuation of 7. An explanation of how the amended claims would be rejected.

Huffman, Kuwamoto and Abbruzzese teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 but fail to explicitly disclose customizing the message text of one or more entries in the database for a particular insurance organization during an installation of the insurance claims processing program on a computer system. Ertel teaches customizing the message text of one or more entries in the database for a particular insurance organization during an installation of the insurance claims processing program on a computer system (Ertel; column 13, lines 37-45). In particular, Ertel teaches "[s]hort, brief and full-text messages are available for each edit check. The content length of messages displayed or printed is dependent upon the appropriateness of detail to the recipient..." (Ertel; column 11, lines 40-44, column 12, lines 47-54); Abbruzzese teaches "[t]he Local Data function provides each office with the same number of generic numeric, date and alphanumeric fields (each of which is also of a predetermined length) to arrange into customized screens. Once these fields have been arranged into a particular display format for use in a local office, they can only be modified by an operator with the proper level of authority. Any number of these fields can be employed and there is no requirement that all/any of them be used. Since the fields are generic, they can be used in any format to store any information desired by the local claims office," (Abbruzzese; column 9, lines 13-30). Examiner interprets these teachings as reading on "customizing the message text of one or more entries in the database for a particular insurance organization." It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system of Huffman, Kuwamoto, and Abbruzzese to include customizing the message text of one or more entries in the database for a particular insurance organization during an installation of the insurance claims processing program on a computer system, as taught by Ertel, with the motivation of managing the process of improving the quality and accuracy of reportable insurance claims data, allowing the analysis of claims data for the purpose of identifying and correcting both case-specific and systematic problems in data quality in the most efficient way possible, making it possible to prioritize individual cases for in-depth review based upon user-defined criteria of importance, automatically routing relevant data quality messages to the appropriate recipient personnel, and providing a method and system to improve the accuracy, completeness, and overall quality of claims data (Ertel; column 5, lines 20-53).